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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,385	12/21/2001	Ralf Schueler	212354US0	5828

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 12/21/01, 11/19/02 and 5/15/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-42 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-42 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received
- in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 4, 6
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 21-30 and 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, the basis upon which the contents of components A and B were determined is not apparent.

In claim 30, it is unclear if or how the recited "additives" further limit the subject matter of the base claim, i.e., are said "additives" in addition to the materials defining component B?

Claims 40-42 are indefinite in that it is unclear as to whether the recited graft copolymer and polyester components are in addition to those of the molding composition of the base claims. Further, is there an "adding" first step followed by a "forming" second step?

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1711

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-30, 34-39, 41 and 42 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,355,358 (Boer et al).

Boer et al disclose multiplayer composites which have at least one layer I of a thermoplastic molding composition, at least one layer II of a further thermoplastic molding composition, bonded together with at least one layer of an adhesion promoter disposed between at least one layer I and at least one layer II. In one embodiment, the adhesion promoter comprises

- I) 5 to 60 parts by weight of a graft copolymer prepared from a polyamine and polyamide-forming monomers (corresponding to applicants' graft copolymer),
 - II) from 10 to 85 parts by weight of a polyamide,
 - III) from 10 to 85 parts by weight of a polyester (corresponding to applicants' polyester),
- where the sum of the parts by weight of I, II and III is 100; and
- IV) up to 40 parts by weight of additives.

Attention is specifically directed to column 8, lines 7-26 and Examples E3, E4 and E5.

The disclosure of the reference meets the requirements of the present claims both in terms of the types of materials added and their contents. It is reasonably believed that the products of the reference inherently meet all the characteristics, e.g., concentration of amino groups in the graft copolymer, governing the presently claimed compositions. The onus is shifted to applicants to establish that the products of the present claims are not the same as or obvious from those set forth by the prior art.

Claim Rejections - 35 USC § 103

5. Claims 1-31, 33, 34, 36, 37 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1210790 in view of U.S. 3,442,975 (Cawthon).

GB '790 discloses a composition comprising (a) 5-80% by weight of a graft copolymer having a polyimine backbone and polyamide side chains and (b) from 95-20% by weight of a polyester. The graft copolymers are prepared by polymerizing a lactam and about 0.1 mol to about 25 moles, per 100 moles of lactam, of a polyimine having a molecular weight of at least 20,000. In Example III, 50 parts of the graft copolymer and 50 parts of polyethylene terephthalate are blended and extruded to form a filament product. The disclosure of the reference meets the requirements of the present claims with respect to the types of materials added. The onus is shifted to applicants to establish that the graft copolymer and polyester components of the present claims are not the same as the corresponding components of the reference.

In essence, the disclosure of the reference differs from the presently claimed invention in not expressly exemplifying a composition meeting the presently claimed graft copolymer contents. With respect to the contents set forth in applicants' claims 11 and 21, it is submitted that it would have been obvious to one having ordinary skill in the art to have employed said claimed contents of graft copolymer with the reasonable expectation of success because such amounts are clearly within the inventive scope of the reference's disclosure of 5-80%. With respect to using less than 5 parts by weight of the graft copolymer, as prescribed by applicants' claim 1, based on the disclosure at page 2, lines 50-54, one having ordinary skill in the art would have found it obvious to employ the graft copolymer in an amount slightly less than 5% by

Art Unit: 1711

weight with the reasonable expectation of success, i.e., no impairment in dyeability properties. Accordingly, absent evidence of usual or unexpected results for the upper limit of graft copolymer in claim 1, as opposed to the reference's preferred lower limit of 5%, no patentability can be seen in applicants' claim 1 embodiment.

With respect to the additional additives of claim 21, attention is directed to the teachings of Cawthon et al, directed to an analogous polyimine/polyamide graft copolymer that can be admixed with polyester, for the conventionality of adding well known additives to the polymer composition in the production of filaments. In light of said teachings, it would have been obvious to one having ordinary skill in the art to have modified the compositions of GB '790 with conventional additives for their expected additive effects.

6. Claims 1-10, 31-33 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,355,358 (Boer et al) described hereinabove.

In essence, the disclosure of Boer et al differs from the above-rejected claims in not expressly disclosing the use of "less than 5 parts by weight" of the graft copolymer. Patentees' preferred amount of graft copolymer in the adhesion promoter composition is 5% by weight. Said amount, however, is merely seen as the preferred amount given that there is no contra disclosure against using less than 5% by weight. Accordingly it is maintained that one having ordinary skill in the art would find it obvious to employ the graft copolymer in an amount slightly less than the reference's preferred 5% by weight with the reasonable expectation of success, absent evidence of unusual or unexpected results.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 1711

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 11-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,355,358. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims generically encompass the subject matter of the patented claims.

9. Claims 1-31, 33, 34, 36, 37 and 39-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/022,878. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims generically encompass the subject matter of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (703) 308-2401. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (703) 308-2462. The fax phone numbers for the

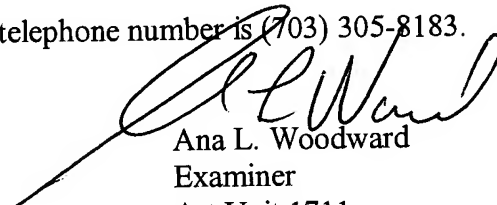
Application/Control Number: 10/024,385

Page 7

Art Unit: 1711

organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8183.



Ana L. Woodward
Examiner
Art Unit 1711

AW
June 27, 2003